



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,984	11/30/2000	Steve Lemke	PALM-3280.US.P	6291
49637 7590 03/19/2007 BERRY & ASSOCIATES P.C. 9255 SUNSET BOULEVARD SUITE 810 LOS ANGELES, CA 90069			EXAMINER PICH, PONNOREAY	
			ART UNIT 2135	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			03/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/727,984

Applicant(s)

LEMKE, STEVE

Examiner

Ponnoreay Pich

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to amendments filed on 1/31/2007. The amendments and arguments with respect to amended claims were fully considered, but are moot in view of new rejections presented below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 8, 3, 9, 4, 10, 6, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Chadha (US 5,963,908).

Claim 1:

Chadha discloses:

1. Gaining access to said computer network by use of a portable computing device (col 2, lines 40-51).
2. Reading biometric data peculiar to a user by use of a biometric reader coupled to said portable computing device (Fig 1-2 and col 4, lines 16-25).
3. Comparing said biometric data peculiar to said user to previously stored biometric data stored in said portable computing device and said computer network (col 4, lines 19-28 and 56-67) for the purpose of identifying the user, and wherein said previously stored biometric data is operable to be removed from said portable computing device on instruction by a remote station on said

computer network, said remote station retaining a copy of said biometric data (Fig 4 and col 4, lines 56-67). *Note the embodiment shown in Figure 4 has the master biometric/voice data stored in a database 310, i.e. the remote station. To do a comparison, a copy of the master biometric data is copied to the portable device 300 and compared with the sample provided by the user via biometric/voice capture circuit 160. It is noted that the language "wherein previously stored biometric data is operable to be removed from said portable computing device..." appears to be reciting an intended use of the previously stored biometric data and is not given patentable weight. Note further that there is no restriction in Chadha that the temporarily stored biometric data cannot be deleted based on instructions from a remote station, thus the temporarily stored biometric data stored in the portable device is operable to be deleted based on the recited instructions. Further, because database 310 stores the master copy of the biometric data, database 310 retains a copy of the biometric data.*

4. Denying further access to said computer network and said portable computing device if said comparing step fails to identify said user as an authorized user and powering down said portable computing device (col 4, lines 27-35; Fig 3a, step 225; and Fig 3b, steps 230 and 235). *Because access to the network is provided via the portable device, if the device is shutdown based on a failed comparison, then further access to the network is also denied.*

Claim 8:

The limitations recited in claim 8 are substantially similar to what is recited in claim 1 and are rejected for similar reasons given therein.

Claims 3 and 9:

Chadha further discloses wherein said biometric data is a fingerprint (col 3, lines 8-12).

Claims 4 and 10:

Chadha further discloses wherein said biometric data is an iris scan (col 3, lines 8-12).

Claim 6:

Chadha further discloses wherein said biometric data can be programmed into said portable computing device by a remote station on said computer network (col 4, lines 56-67).

Claim 12:

Chadha further discloses wherein said previously stored biometric data stored in said portable computing device can be controlled by a remote station on said computer network (Fig 4 and col 4, lines 56-67).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 13-14, 17-19, and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chadha (US 5,963,908).

Claim 2:

Chadha does not explicitly disclose said access to said network is by use of a wireless connection. However, official notice is taken that accessing a network via a wireless connection was well known in the art at the time applicant's invention was made. It would have been obvious to one skilled in the art to modify Chadha's invention such that said access to said network is by use of a wireless connection because it would increase the mobility of Chadha's laptop seen in Figures 1 and 4.

Claim 13:

Chadha discloses:

1. A computer network, said computer network comprising one or more computer workstations, wherein access to said computer network is provided by said one or more workstations upon authentication of biometric data from a user (col 2, lines 40-46 and col 3, lines 13-20).
2. A portable computing device, said portable computing device providing access to said computer network and wherein said portable computing device is powered down upon unsuccessful authentication of biometric data from said user (col 2, lines 48-51; col 4, lines 28-33; Fig 1, item 100; and Fig 4, item 300).
3. A biometric data reading device coupled to said portable computing device (Fig 1, item 140 and col 3, lines 34-47).

Art Unit: 2135

4. A data storage device for storing biometric data capable of identifying one and only one user (col 4, lines 2-7 and 59-63).
5. A communication device coupled to said computer network, capable of enabling the loading and removing of said biometric data stored in said portable computing device (Fig 4, item 320 and col 4, lines 56-67). *Communication line 320 enables the biometric data stored in database 310 to be uploaded to portable device 300. It also enables the removing of biometric data stored in the portable device because as one skilled should appreciate, biometric data stored in the portable device can be overwritten with other data stored in database 310 via use of communication line 320.*

The limitation "wherein said biometric data is operable to be removed from said portable computing device on instruction by one of said one or more workstations on said computer network, said one of said one or more workstations retaining a copy of said biometric data" appears to describe the characteristics of a material, i.e. biometric data, intended to be used with the claimed apparatus rather than the characteristics of the apparatus itself. As per MPEP 2114-2115, the patentability of a claimed apparatus depends on its structure, not what it does or any materials intended to be used or worked on by the apparatus, thus the limitations is not given patentable weight.

Chadha does not explicitly disclose said portable computing device providing wireless access to said computer network and the communication device being a wireless communication device. However, official notice is taken that portable

Art Unit: 2135

computing devices providing wireless access to computer networks and communication devices being wireless communication devices were well known in the art at the time applicant's invention was made. For instance, wireless cell phones and laptops which connect to the Internet via a wireless network card were well known in the art.

It would have been obvious to one skilled in the art to modify Chadha's invention according to the limitations recited in claim 13 by providing the laptop of Chadha's invention with wireless network access including wireless access to database 310. One skilled would have been motivated to do so because it would increase the mobility of Chadha's laptop seen in Figures 1 and 4

Claim 14:

As per claim 14, Chadha further discloses wherein said portable computing apparatus comprises:

1. A bus (Fig 1 and Fig 4). *All modern personal computers/laptops have a bus.*
2. A memory unit coupled to said bus (Fig 1, item 180). *The memory unit can also read on the laptop's hard drive. One skilled should appreciate that most modern computers have RAM and a hard drive.*
3. A data storage device coupled to said bus, capable of storing said biometric data (Fig 1, item 180).
4. A biometric reader coupled to said bus (Fig 1, item 160, voice capture circuit).
5. A communication device, i.e. NIC, coupled to said bus for communicating with a computer network (col 3, lines 21-27).

Art Unit: 2135

6. A processor coupled to said bus said processor for performing a method for identify a user by use of said biometric data (col 3, lines 35-47 and col 4, lines 19-28), said method comprising the steps of:
 - a. Reading applicable biometric data (Fig 3a, step 210).
 - b. Comparing said biometric data with said biometric data stored in said memory unit (Fig 3a, step 225).

Claim 17:

Chadha further discloses wherein said biometric data is a fingerprint (col 3, lines 8-12).

Claim 18:

Chadha further discloses wherein said biometric data is an iris scan (col 3, lines 8-12).

Claim 19:

Chadha further discloses wherein said biometric data is any electrically storable identifying biometric data (col 3, lines 8-12).

Claim 21:

Chadha further discloses wherein said computer network further comprises a remote station connected to said computer network (Fig 4, item 310 and col 3, lines 13-18). One skilled should appreciate that the Internet comprises several interconnected remote stations.

Claim 22:

As per claim 22, it is noted that the limitations further recited therein is directed towards an intended use of the remote station. As per MPEP 2114, the limitations are not given patentable weight as the patentability of an apparatus depends on its structure not what it does or its intended use.

Further note that database 310 in Figure 4 can be considered the remote station. It contains the master biometric/voice data used to authenticate the user of the laptop 300. Column 4, lines 56-67 discloses downloading the biometric data stored in the database to portable computing device 300 either temporarily or for long term storage. One skilled should appreciate that the data in the database can be used to overwrite previous data downloaded into the laptop, thus the database (remote station) can be used for erasing said biometric data from said portable computing apparatus. Further, for the biometric data to have been stored in the database in the first place, the data must have been uploaded into the database. Official notice is taken that it was well known to be able to upload biometric data from a portable computing device to a remote database. It would have been obvious to one skilled in the art to modify Chadha's invention such that one can register a user by uploading biometric data read from the portable computing device to the remote database 310. One skilled would have been motivated to do so because registering a user is necessary to obtain master biometric data for comparison in authenticating a user.

Art Unit: 2135

Claims 5, 11, 20, and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chadha (US 5,963,908) in view of applicant's admittance of prior art as discussed in applicant's specification, herein referred to as AAPA.

Claims 5, 11, and 20:

Chadha does not explicitly disclose wherein said biometric data comprises one or more measured electrical characteristics. However, AAPA discloses measured electrical characteristics being well known types of biometric data (specification: page 2, lines 16-19). At the time applicant's invention was made, it would have been obvious to one skilled in the art to utilize measured electrical characteristics as biometric data in Chadha's invention. One skilled would have been motivated to do so because the choice of type of biometric data to utilize is a design choice. Chadha discloses that other types of biometric data than the ones he listed can be used (col 3, lines 8-12).

Claim 15:

As per claim 15, Chadha does not explicitly disclose wherein said portable computing device apparatus is a personal data assistant (PDA). However, AAPA discloses PDA's being well known computing devices at the time applicant's invention was made (spec: page 1, lines 10-23).

At the time applicant's invention was made, it would have been obvious to one skilled in the art to utilize Chadha's modified invention with a PDA. One skilled would have been motivated to utilize biometric verification as per Chadha's teachings with PDA's because biometric verification offers a high level of security.

Claim 16:

Art Unit: 2135

Chadha further discloses wherein said biometric reader is implemented as part of the portable computing apparatus (Fig 1, item 160). Note that biometric reader 160 is built into the laptop.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ponnoreay Pich whose telephone number is 571-272-7962. The examiner can normally be reached on 9:00am-4:30pm Mon-Thurs.

Art Unit: 2135

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PP

Ponnoreay Pich
Examiner
Art Unit 2135



KIM VU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100